

# **EXHIBIT 1**

**quinn emanuel trial lawyers | san francisco**

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WRITER'S DIRECT DIAL NO.  
**(415) 875-6415**

WRITER'S INTERNET ADDRESS  
**joshuasohn@quinnemanuel.com**

December 28, 2010

Roland R. Schindler II  
Director, Patent Litigation  
Eastman Kodak Company  
343 State Street  
Rochester, NY 14650-2201

Re: Request for Consent to Produce Confidential Eastman Kodak Documents

Dear Mr. Schindler:

I am writing on behalf of Motorola, Inc. and Motorola Mobility, Inc. (collectively "Motorola"). Motorola is involved in several legal actions in which it is represented by Quinn Emanuel Urquhart & Sullivan, LLP and Ropes & Gray, LLP. Quinn Emanuel represents Motorola in *Certain Mobile Devices, Associated Software, and Components Thereof*, Inv. No. 337-TA-744 (U.S. Int'l Trade Comm'n); *Certain Wireless Communication Devices, Portable Music and Data Processing Devices, Computers and Components Thereof*, Inv. No. 337-TA-745 (U.S. Int'l Trade Comm'n); *Motorola Mobility, Inc., v. Apple Inc. and Next Software, Inc.*, No. 10-867-GMS (D. Del.); and *Motorola Mobility, Inc., v. Apple Inc.*, No. 1:10-cv-23580-UU (S.D. Fla.) Ropes & Gray represents Motorola in *Certain Gaming and Entertainment Consoles, Related Software, and Components Thereof*, No. 337-TA-752 (U.S. Int'l Trade Comm'n); *Motorola Mobility, Inc. and General Instrument Corp. v. Microsoft Corp.*, No. 3:10-cv-00699-WMC (W.D. Wisc.); *Motorola Mobility, Inc. and General Instrument Corp. v. Microsoft Corp.*, No. 3:10-cv-00700-WMC (W.D. Wisc.); and *Motorola Mobility, Inc. and General Instrument Corp. v. Microsoft Corp.*, No. 1:10-cv-24063-FAM (S.D. Fla.).

Opposing counsel in several of these actions have recently asked us to re-produce the documents that Motorola had previously produced in the matter of *Certain Wireless Communication System Server Software, Wireless Handheld Devices and Battery Packs*, Inv. No. 337-TA-706 (U.S. Int'l Trade Comm'n). Some of these previously-produced documents include Eastman Kodak confidential documents, including executed license agreements and/or correspondence relating to

**quinn emanuel urquhart & sullivan, llp**

LOS ANGELES | 865 South Figueroa Street, 10th Floor, Los Angeles, California 90017-2543 | TEL (213) 443-3000 FAX (213) 443-3100

NEW YORK | 51 Madison Avenue, 22nd Floor, New York, New York 10010-1601 | TEL (212) 849-7000 FAX (212) 849-7100

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TOKYO | Akasaka Twin Tower Main Bldg., 6th Floor, 17-22 Akasaka 2-Chome, Minato-ku, Tokyo 107-0052, Japan | TEL +81 3 5561-1711 FAX +81 3 5561-1712

MANNHEIM | Erzbergerstraße 5, 68165 Mannheim, Germany | TEL +49(0) 621 43298 6000 FAX +49(0) 621 43298 6100

various Motorola-owned patents.

In an email dated April 6, 2010, you had given Motorola permission to produce these confidential documents in the *Certain Wireless Communication System Server Software* action. Motorola hereby seeks your permission to re-produce these same documents in the actions listed in the first paragraph of this letter. Naturally, Motorola would designate these documents with the highest level of confidentiality allowed by the protective orders in these actions.

Please let us know if we have your consent to re-produce these documents. Should we not hear from you, we plan to produce these documents by January 31, 2011. Please feel free to contact me at any time with questions or concerns. Thank you in advance for your consideration.

Very truly yours,

Joshua L. Sohn

Joshua L. Sohn

# **EXHIBIT 2**

**McDonough, Conor B.**

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**From:** sheila.popowych@kodak.com  
**Sent:** Wednesday, January 19, 2011 4:33 PM  
**To:** Joshua Sohn  
**Cc:** Robert R. Cleary; scott.clark@kodak.com  
**Subject:** RE: Motorola Request for Production of Documents

Joshua - based on what you have provided below, Kodak gives its consent for producing the Motorola license agreement in the referenced actions. As to the district court actions that are not yet governed by protective order, we request that the license agreement, should it require production, be marked under the highest standard of confidentiality, i.e. outside counsel attorney's eyes only.

Regards,

Sheila L. Popowych  
Paralegal, Eastman Kodak Company  
343 State Street  
Rochester, New York 14650-00205  
phone: (585) 781-1588  
KNET: 27-11588  
fax: (585) 724-6611

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From: Joshua Sohn <[Joshuasohn@quinnemanuel.com](mailto:Joshuasohn@quinnemanuel.com)>  
To: "[sheila.popowych@kodak.com](mailto:sheila.popowych@kodak.com)" <[sheila.popowych@kodak.com](mailto:sheila.popowych@kodak.com)>  
Cc: "[scott.clark@kodak.com](mailto:scott.clark@kodak.com)" <[scott.clark@kodak.com](mailto:scott.clark@kodak.com)>, "Robert R. Cleary" <[robertcleary@quinnemanuel.com](mailto:robertcleary@quinnemanuel.com)>  
Date: 01/18/2011 08:26 PM  
Subject: RE: Motorola Request for Production of Documents

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Dear Sheila,

Attached is the lone document reflecting Kodak confidential information that we wish to produce. It is a Kodak-Motorola license agreement ("Agreement"). The patents specifically referenced in this Agreement are listed on page 8 and Exhibits 2 and 3 in the Agreement.

I also am attaching the protective orders for the three International Trade Commission actions referred to in my letter. Regarding the five U.S. District Court actions, no protective orders have yet been entered. As soon as the protective orders are entered in these District Court actions, I will forward the protective orders on to you. In the meantime, please let us know whether we have Kodak's consent to produce the Agreement in the International Trade Commission actions. Thank you again for your consideration.

**Joshua Sohn**  
*Associate,*  
**Quinn Emanuel Urquhart & Sullivan, LLP**

50 California Street, 22nd Floor  
San Francisco, CA 94111  
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415.875.6600 Main Office Number  
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[www.quinnemanuel.com](http://www.quinnemanuel.com)

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**From:** [sheila.popowych@kodak.com](mailto:sheila.popowych@kodak.com) [<mailto:sheila.popowych@kodak.com>]

**Sent:** Thursday, January 06, 2011 2:47 PM

**To:** Joshua Sohn

**Cc:** [scott.clark@kodak.com](mailto:scott.clark@kodak.com)

**Subject:** Motorola Request for Production of Documents

Joshua - we are in receipt of your December 28 letter to Roland Schindler in which you request Kodak consent to produce confidential documents, including the license agreement to which Kodak and Motorola are a party, as well as patent related correspondence, in 8 different pending ITC and/or District Court actions.

Before providing consent, we request a copy of the Protective Order in place for each of these cases - Kodak will mandate that our documents be produced under an outside counsel attorney eyes only confidentiality designation. In addition, we ask that you provide us with the patent numbers of the "correspondence [*to which Kodak is a party*]" relating to various Motorola owned patents."

We look forward to hearing from you.

Sheila L. Popowych  
Paralegal, Eastman Kodak Company  
343 State Street  
Rochester, New York 14650-00205  
phone: (585) 781-1588  
KNET: 27-11588  
fax: (585) 724-6611

The information in this e-mail is the property of Kodak and may be confidential. It is intended for the named recipient(s) only. If you have received it in error, please inform the sender and delete the message. Thank you. Please note that neither Kodak nor the sender accepts any responsibility for viruses and it is your responsibility to scan the e-mail and any attachments.[attachment "Kodak.pdf" deleted by Sheila L. Popowych/488615/EKC] [attachment "337-TA-744 Protective Order.pdf" deleted by Sheila L. Popowych/488615/EKC] [attachment "337-TA-745 Protective Order.pdf" deleted by Sheila L. Popowych/488615/EKC] [attachment "337-TA-752 Protective Order.pdf" deleted by Sheila L. Popowych/488615/EKC]

# **EXHIBIT 3**



ROPES & GRAY LLP  
ONE METRO CENTER  
700 12TH STREET, NW, SUITE 900  
WASHINGTON, DC 20005-3948  
WWW.ROPESGRAY.COM

April 5, 2010

Matthew J. Rizzolo  
202-508-4715  
202-383-9856 fax  
Matthew.Rizzolo@ropesgray.com

**VIA E-MAIL**

Mr. Hisao Yamasaki  
General Manager, IP Licensing  
Hitachi, Ltd.  
New Marunouchi Bldg., 5-1,  
Marunouchi 1-chome  
Chiyoda-ku, Tokyo 100-8220  
Japan

Dear Mr. Yamasaki:

I write to follow up on Hiro Hagiwara's March 16 letter and my April 1 e-mail regarding the production of two license agreements between Motorola and Hitachi in a pending investigation (Inv. No. 337-TA-706) before the United States International Trade Commission which involves our client, Motorola, and Research In Motion ("RIM").

Because these licenses are responsive to RIM's discovery requests, and due to the rapid pace at which an ITC investigation progresses, we plan to produce the license agreements under the Protective Order entered in the case as HITACHI CONFIDENTIAL BUSINESS INFORMATION. According to terms of the Protective Order, these license agreements would only be viewable by the parties' outside counsel, expert witnesses who subscribe to the Protective Order, and ITC personnel, so Hitachi's confidential information would remain well-protected.

I have enclosed the license agreements, as well as the Protective Order entered by the Administrative Law Judge in this investigation. Please let me know by Wednesday, April 7, 2010 if Hitachi has any objection to the production of this license in this investigation as Hitachi Confidential Business Information. Thank you very much for your consideration and your cooperation in this matter.

If you have any questions, please contact me at [matthew.rizzolo@ropesgray.com](mailto:matthew.rizzolo@ropesgray.com) or (202) 508-4715.

Sincerely yours,

A handwritten signature in black ink, appearing to read "M. Rizzolo".

Matthew J. Rizzolo

Enclosures



# **EXHIBIT 4**

**McDonough, Conor B.**

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**From:** hisashi.kumazaki.ek@hitachi.com  
**Sent:** Monday, April 05, 2010 10:14 PM  
**To:** Rizzolo, Matthew  
**Cc:** hisao.yamasaki.qw@hitachi.com; hiroyuki.okutsu.mk@hitachi.com  
**Subject:** Re:Fw:RE: Motorola's Request

Dear Mr. Rizzolo:

Your emails addressed to Mr. Hisao Yamasaki were transferred to me.  
I apologize for our delay in response.

We do not object to your production of two patent license agreements between Motorola and Hitachi (i.e. CELLULAR ESSENTIAL PROPERTIES CROSS LICENSE AGREEMENT - SUBSCRIBER and CELLULAR ESSENTIAL PROPERTIES CROSS LICENSE AGREEMENT INFRASTRUCTURE) under the protective order entered in ITC Inv. No. 337-TA-706, which allows only outside counsel, expert witnesses and ITC personnel to view those two agreements.

Thank you for notifying Hitachi of this discovery request.

Best regards,

Hisashi Kumazaki  
General Manager, IP Licensing Department  
Intellectual Property Group, Hitachi, Ltd.  
Address: Marunouchi Center Building, 6-1 Marunouchi 1-chome  
Chiyoda-ku, Tokyo 100-8220 Japan  
e-mail: hisashi.kumazaki.ek@hitachi.com

>----- Begin of forwarded message -----

>TO: 山崎\_\_寿郎

>送信者 : Matthew.Rizzolo@ropesgray.com

>主題 : RE: Motorola's Request

>受信日 : 2010/04/05 22:03

>属性 : なし

>

>

>Dear Mr. Yamasaki:

>

>I sincerely apologize for the multiple requests, but I have not yet received a response from you regarding Hiro Hagiwara's March 16 email, nor my April 1 email. Please see the attached letter, the protective order entered in ITC Inv. No. 337-TA-706, and two licenses between Hitachi and Motorola. As the letter states, the licenses are responsive to RIM's discovery requests and we intend to produce them under the protective order as "Hitachi Confidential Business Information." As such, the licenses would be viewable only by the parties' outside counsel, expert witnesses, and ITC personnel. If you have any objections to this plan, please let me know by Wednesday, April 7. Thank you - Ropes & Gray and Motorola appreciate your cooperation in this matter.

>  
>Regards,  
>  
>Matt  
>  
>  
>  
>Matthew J. Rizzolo  
>ROPES & GRAY LLP  
>T +1 202 508 4715 | F +1 202 383 9856  
>One Metro Center, 700 12th Street, NW, Suite 900  
>Washington, DC 20005-3948  
>Matthew.Rizzolo@ropesgray.com  
><http://www.ropesgray.com/>  
>  
>  
>\_\_\_\_\_  
>From: Rizzolo, Matthew  
>Sent: Thursday, April 01, 2010 9:45 AM  
>To: hisao.yamasaki.qw@hitachi.com  
>Subject: FW: Motorola's Request  
>  
>Dear Mr. Yamasaki:  
>  
>I write to follow up on Mr. Hagiwara's March 16 request, which is attached below. Have you had a chance to review the request and the attached documents? Please let me know whether Hitachi will consent to the production of the attached license agreements in the ITC Investigation identified below as Confidential Business Information, viewable only by the parties' outside counsel, expert witnesses, and ITC personnel. If you have any questions, please do not hesitate to contact me. Thank you for your time and consideration.  
  
>  
>Regards,  
>  
>Matt  
>  
>  
>Matthew J. Rizzolo  
>ROPES & GRAY LLP  
>T +1 202 508 4715 | F +1 202 383 9856  
>One Metro Center, 700 12th Street, NW, Suite 900  
>Washington, DC 20005-3948  
>Matthew.Rizzolo@ropesgray.com  
><http://www.ropesgray.com/>  
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>-----  
>From: Hagiwara, Hiroyuki  
>Sent: Tuesday, March 16, 2010 4:45 AM  
>To: hisao.yamasaki.qw@hitachi.com  
>Cc: katsuyuki.uchiyama.sf@hitachi.com; Rizzolo, Matthew; Jenner, Jesse J.  
>Subject: Motorola's Request

>  
>Dear Yamazaki san,

>  
>I hope this message finds you well.

>  
>Our firm represents Motorola against RIM in Section 337 ITC Investigation No. 337-TA-706. I write to convey Motorola's request for Hitachi's consent to produce Hitachi confidential documents which were requested by RIM in the subject litigation. Given the compressed discovery schedule, Motorola would appreciate your prompt response and kind consent. Our firm's litigation team for Motorola identified the attached agreements as relevant, responsive and confidential documents. I also attached a copy of the applicable protective order. We would produce the documents, if Hitachi consents, under the terms of the protective order.

>  
>If you have any questions, please contact Matthew Rizzolo (Washington DC) or myself.

>  
>Thank you for your consideration of this matter on Motorola's behalf.

>  
>Best regards,

>  
>Hiroyuki Hagiwara  
>ROPES & GRAY LLP  
>T 81-3-6259-3516 | F 81-3-6259-3517  
>Yusen Building 2F  
>3-2, Marunouchi 2-chome  
>Chiyoda-ku, Tokyo  
>100-0005 Japan  
>Hiroyuki.Hagiwara@ropesgray.com  
><http://www.ropesgray.com/>

>  
><< File: Inv No 337-TA-706 Protective Order.pdf >> << File: Hitachi Cellular Subscriber License\_4-6-04.pdf >> << File: Hitachi Cellular Infrastructure License\_4-1-04.pdf >> << File: Active\_24421204\_1\_Letter to Hitachi.DOC >>

>  
>  
>----- End of forwarded message -----